



UNITED STATES PATENT AND TRADEMARK OFFICE

EC

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,244	10/17/2001	Michael H. D'Amico	13253US01	7628

7590

07/17/2003

Ronald E. Larson
McAndrews, Held & Malloy, Ltd.
34th Floor
500 W. Madison Street
Chicago, IL 60661

EXAMINER

BROCKETTI, JULIE K

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 07/17/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,244

Applicant(s)

D'AMICO ET AL.

Examiner

Julie K Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-30-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 11-31, 33 and 35-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-31, 33 and 35-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2003 has been entered.

Claim Objections

Claim 18 is objected to because of the following informalities:

Claim 18 states "a network arranged transmit data resulting..." The word "to" needs to be inserted between "arranged" and "transmit".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3713

Claims 1-7, 9, 14 and 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al., U.S. Patent No. 4,722,053 in view of Walker et al., U.S. Patent No. 6,110,041 in further view of Falciglia, U.S. Patent No. 5,971,849. Dubno et al. discloses a food service ordering terminal with video game capability. The gaming system comprises a service station and a first gaming location, which enables game play. An apparatus enables communication between the service station and the first gaming location. An interactive first communication unit is operable from the first gaming location. It includes a first display visible from the first gaming location operable to display a first message. An interactive second communication unit is operable from the service station and includes a second display visible from the service station operable to display a second message. A network is arranged to transmit data so that messages are displayed on the first and second displays (Figs. 1 & 3; col. 2 lines 5-20). The first and second display can comprise touch screen displays, which involves touching the display (col. 4 lines 43-47). The first gaming location comprises a gaming machine and the first display is coupled to the gaming machine (col. 2 lines 10-13). The apparatus can contain a keypad operable from the gaming locations wherein the second display displays a message comprising data entered by the keypad (col. 3 lines 46-52). The first and second communication units display images on their respective display, which is then suitable for entry of at least one of numeric data and

Art Unit: 3713

alphabetic data by touching the respective display. Moreover, the first display can display a message depending on a preference of a player at the first gaming location thus it is displaying the message interactively. For example, it can display a bill total, or a message informing the customer that the kitchen is out of a particular item (col. 2 lines 61-67; col. 4 lines 40-47). Consequently, the message generated at the service station comprises a reply to a message generated at the first gaming location, i.e. the customer's order. Replies can be transmitted back and forth between both stations. Dubno et al. lacks in disclosing a card reader and storing a player's preference prior to displaying the message and also lacks in displaying the message unrelated to the play of the game without interrupting the game.

Walker et al. discloses a gaming device in which the system comprises a central authority and a card reader, the card reader is operable from a first gaming location and arranged to read a code from the card entered by the player at the gaming location. The player's preference is stored in the central authority and the player's preference is accessed in response to the code (See Walker col. 3 lines 30-54; col. 5 lines 1-15). It is obvious to store a player preference in memory so that any game activity can be to a player's preference. Player preferences could be from how they want the display arranged to the type of personal services they enjoy. Therefore, it is obvious to store how a player wants messages received on their display prior to actually displaying any message. Consequently, the display is varied based on the preference of a

Art Unit: 3713

player at the gaming location. When a player enters the card into the gaming machine they are tracked thus authorizing the casino to be located. It is obvious that the central authority could have a second display arranged to display an identification of the location of the player in response to the code on the player's card (See Walker col. 6 lines 39-46). It would have been obvious at the time the invention was made to insert a card tracking system into the invention of Dubno et al. By player's using cards, they do not have to carry money with them and the service center can readily know the player's preferences so as to cater to them in the manner they enjoy.

Falciglia teaches of a computer based game system in which player's chat during game play. The messages are unrelated to the game play and are displayed without interrupting the game. Furthermore, players may enter the name of a person (See Falciglia Fig. 7). It would have been obvious at the time the invention was made to use the messaging system of Falciglia in the game of Dubno. By displaying the messages while the game is still being played, game play is not interrupted and does not distract a player's attention or concentration when involved in the game. Player's can concentrate both on the game and read the messages simultaneously.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view of Walker et al. in view of Falciglia in further view of Rapoport et al., U.S. Patent No. 5,262,938. Walker lacks in disclosing using a map to locate a player. Rapoport et al. teaches of a food services routing

Art Unit: 3713

system that displays a map on a computer screen to locate a particular guest (See Rapoport et al. Fig. 2). It would have been obvious at the time the invention was made that the casino central server could contain a map of the location of the player. By being able to track players by their card and arrange gaming preferences for them, the players are happier and will continue to play more. Furthermore, maps make it easier for employees to locate the players.

Claims 13, 15, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view of Walker et al. in further view of Hedrick et al., U.S. Patent No. 6,135,884. Dubno et al. lacks in disclosing a menu of reservation services and personal messages. Hedrick teaches of a gaming machine having a secondary display. The secondary display is used to display a menu of reservation services available or a menu of personal message services available. The display at the gaming machine can display a message sent to it from the service station (See Hedrick col. 15 lines 55-67; col. 16 lines 1-5). It would have been obvious at the time the invention was made to include these menu options into the invention of Dubno et al. These options allow individuals to accesses messages and other services while they are playing a game so as not to have to move in order to order these services. By including these services into the gaming machine itself, the game machine can retain a person's attention longer and they will more likely spend more money at the establishment.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view of Walker et al. in further view of Hedrick et al. in further view of Falciglia. Hedrick lacks in disclosing enabling entry of a name of a person and a message. Falciglia, teaches of a computer-based system and method in which a player may enter a name of a person and a message to be sent to another player (See Falciglia Fig. 7). It would have been obvious at the time the invention was made to allow players to input a message and player's name in the invention of Hedrick et al. so that player's could chat with each other while playing their games, thus providing further enjoyment.

Claims 12 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view Walker et al. in further view of Franchi, U.S. Patent No. 5,770,533. Dubno et al. lacks in disclosing displaying a menu of personal services available. Franchi teaches of a casino operating system in which slot machine include menus displaying a plurality of personal service available (See Franchi Fig. 13; col. 8 lines 20-44). It would have been obvious at the time the invention was made to include a menu of personal services available in the invention of Dubno et al. A customer can then order other services and enjoy their time at the restaurant more fully.

Claims 16, 17 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubno et al. in view of Walker et al., in further view of Ehrman, U.S. Patent No. 5,984,786. Dubno et al. and Walker et al. lack in disclosing a second gaming location in communication with the first. Ehrman

Art Unit: 3713

teaches of a first gaming machine that accommodates a first player. A first communication unit enables a player to chat with a second player through entry of a first message. Ehrman further discloses a central authority and a second gaming location comprising a third display. A player may communicate with another gaming machine through the central authority. The central authority is arranged to transmit data resulting in display of a message on the third display and wherein the first display displays a message received from the second gaming location. The message on the third display comprises a message received from the first gaming location. Furthermore, the central authority identifies the gaming location and player in response to a message sent (See Ehrman col. 7 lines 48-67; col. 8 lines 1-10). It is obvious that both in order to chat, both players must enter the name of the other player for identification purposes or as one would when writing a letter. It is also well known to enter the code such as an ID number, of another player in order to chat. E-mail, instant messaging, etc. are all well known throughout the art, various message services require a user to enter the name and ID of a recipient. It would have been obvious at the time the invention was made to enter the name and code of the recipient in order to send a message in Ehrma. By inputting this information, the central authority knows where to send the message.

Claims 18, 19, 21-23 and 41-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrman, U.S. Patent No. 5,984,786. Ehrman teaches

Art Unit: 3713

of a first gaming machine that accommodates a first player. An interactive first communication unit enables a player to chat with a second player through entry of a first message. Ehrman further discloses a central authority and a second gaming location, which accommodates a second player comprising a third display and a second interactive communication unit. A player may communicate with another gaming machine through the central authority. The central authority identifies the gaming locations in response to the name and code of the player being entered. A network is arranged to transmit data resulting in display of the first message on the second display and arranged to transmit data resulting in display of the second message on the first display. The central authority is arranged to transmit data resulting in display of a message on the third display and wherein the first display displays a message received from the second gaming location. The message on the third display comprises a message received from the first gaming location. Furthermore, the central authority identifies the gaming location and player in response to a message sent (See Ehrman col. 7 lines 48-67; col. 8 lines 1-10). The game system includes an alphanumeric keypad operable from the first gaming location wherein the second message comprises data entered by the keypad. Each of the first and second communication unit displays an image on one of the first and second displays suitable for entry of at least one of numeric data and alphabetic data by touching one of the first or second displays (Fig. 3A). It is obvious that both in order to chat, both players must enter the name of the

Art Unit: 3713

other player. It is also well known to enter the code such as an ID number, of another player in order to chat. E-mail, instant messaging, etc. are all well known throughout the art, various message services require a user to enter the name and ID of a recipient. It would have been obvious at the time the invention was made to enter the name and code of the recipient in order to send a message in Ehrman. By inputting this information, the central authority knows where to send the message.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrman, U.S. Patent No. 5,984,786 in view of Walker et al., U.S. Patent No. 6,110,041. Ehrman lacks in disclosing card readers. Walker et al. teaches of gaming devices with card readers. Each card reader is operable from each gaming location and arranged to read a code from the card entered by the player at the gaming location. The central authority can then identify the gaming location in response to the code (See Walker col. 3 lines 30-54).

Response to Amendment

It has been noted that claims 1, 12, 24, 36 and 38 have been amended.

Response to Arguments

Applicant's arguments filed May 29, 2003 have been fully considered but they are not persuasive.

The Applicant argues that Dubno interrupts the game in order to display a message. The Examiner agrees and has now added the reference Falciglia to the rejection of claim 1. Falciglia clearly displays a message on a gaming machine without interrupting game play.

The Applicant argues that Walker et al. does not store player preferences of how they want messages received or displayed. While Walker does not specifically state that a player may insert their preference of how they want messages displayed it is obvious that this could a preferred feature. Walker discloses numerous player "configuration" preferences including, language, sound options, speed of reels, number of coins played etc. It would have been just as obvious to configure the display to a player's preference just as a computer user configures their home computer display windows. Configuring display windows on a monitor is well known in the computing art and is an obvious feature. Therefore, since Walker, allows player's to save their preferences to a card, the display preference can also be saved for future retrieval.

The Applicant argues that Walker does not teach of a player preference authorizing the player to be located. The Examiner disagrees and notes that every time the player inserts their preference card into a machine they are authorizing the casino to "track" or locate them (See Walker col. 6 lines 39-46). The Applicant argues that the player may not want to be located. This does not matter, every time a player inserts a player preference card as in Walker into

Art Unit: 3713

the gaming machine, the casino knows who the player is and what machine they are playing including the location of the machine. These are features, which are inherent to any type of player tracking card.

The Applicant argues that Walker does not disclose a map to locate a player, therefore, the reference Rapoport et al, U.S. Patent No. 5,262,938 has been added.

The Applicant argues that no reference discloses claim 13 in which a menu of reservation services depending on a preference of a player stored in memory is displayed. The Examiner disagrees and notes that Hedrick clearly discloses a menu of reservation services and Walker clearly discloses storing player preferences including their likes and dislikes thus it is obvious to store only the reservation services that a player would be interested in on the player tracking card.

The Applicant notes that neither Hedrick, Walker nor Dubno teach of enabling entry of a name of a person. The Examiner agrees and notes that the Falciglia reference has been added.

The Applicant argues that in claim 15 a display of a message is sent to the first display from the service station depending on a preference of a player stored in memory, and that none of the references disclose this combination. The Examiner disagrees and points the Applicant to the rejection above.

Art Unit: 3713

The Applicant argues that Dubno and Franchi do not teach or suggest the feature of claim 12. The Examiner has added the reference Walker to clarify this rejection.

The Applicant argues that Ehrman does not teach or suggest entry of a player name or code. The Examiner disagrees and notes that when two players are in a chat session they commonly enter the other person's name for identification purposes or as one would when writing a letter. Furthermore, it is well known that one has to enter a name or code, i.e. an e-mail address, ISP, etc. to initiate a chat session with another person.

The Applicant argues that a player may not want his identity revealed. This is irrelevant. When a player initiates a chat session they must select a user name for themselves for entry into the computer. They must also enter the names of any other person they wish to chat with. So even though they might not want their identity revealed they must use some sort of "handle" whether it is a made up name or an ID number.

In regards to claim 18, Ehrman clearly discloses at two gaming locations with players and communication units. As previously stated it is obvious for a player to enter the name or code, i.e. handle, e-mail address, ISP, etc. in order to send a message to another player.

The Applicant argues that Ehrman cannot locate a gaming location by means of such name or code. The Examiner disagrees and notes that in order to message the other player some sort of identifying means must be input into

Art Unit: 3713

the computer such as their name or code, i.e. handle, e-mail address, ISP, etc. It is inherent to the system that once a player enters one of the aforementioned identifications, the computer can determine the location of the other person based on the entered information.

In regards to claim 20 the Applicant argues that there is no known part of Walker that teaches or suggests locating a gaming location in response to the code read from a card as claimed. The Examiner disagrees and notes that every time the player inserts their preference card into a machine they are authorizing the casino to "track" or locate them (See Walker col. 6 lines 39-46). The Applicant argues that the player may not want to be located. This does not matter, every time a player inserts a player preference card as in Walker into the gaming machine, the casino knows who the player is and what machine they are playing including the location of the machine. These are features, which are inherent to any type of player tracking card.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike O'Neill "Acting SPE" can be reached on 703-308-

Art Unit: 3713

1148. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.

JB

July 16, 2003



**MICHAEL O'NEILL
PRIMARY EXAMINER**